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EXAMINER

BASHORE, ALAIN L

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/560,215

Applicant(s)

LEVCHIN ET AL.

Examiner

Alain L. Bashore

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10-2-02 and telephone interview.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 and 39-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37, and 39-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 16.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***New first office action***

1. In response to the telephone interview of 3-12-03, this new office action is sent which includes: further explanation located in "response to arguments" section, further 35 USC 112 rejection, and a new 35 USC 101 rejection, as discussed with the attorney of record. The time for response is restarted with the mailing of this new office action.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, a new official first office action follows.

### ***Claim Objections***

2. Claim 22 is objected to because of the following informalities:

In claim 22, there appears to be a lack of antecedent basis for "the form".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4, 24 and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 is confusing since it appears that the transferring recitation contradicts the exchanging recitation all within the same claim structure.

Claim 24 is confusing because it refers to a step (d) that is not presently recited in claim 1.

Claim 43 is confusing since there is recited that the unregistered party is registered prior to value transfer, but in the later value transfer recitation step the value is transferred to an unregistered party.

Claims 34-37, 42 recite "system" which is vague and indefinite since a system may be one of several different statutory classes of invention (including a method or an apparatus). Applicant must indicate on the record what statutory class of invention the system claims belong to. For the purposes of this examination these claims are considered apparatus.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5, 8, 10-11, 20-24, 26-28 are rejected under 35 U.S.C. 101 as non-statutory. The method claims as presented do not claim a technological basis in the body of the claim. While the specification discloses such a basis, there is no basis claimed. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim at least one structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) – used only for content and reasoning since not precedential].

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, 8-11, 20, 22, 24-25, 34-39, 44-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett in view of Kasai et al.

Doggett et al discloses a method of facilitating a value exchange between multiple users in a system using a network system. A first user is assigned a first account with the value exchange system (col 4, lines 37-53). The value exchange system receives a value exchange transaction from the first user, wherein said transaction involves a second user (col 6, lines 1-3) or may utilize. A pre-existing identifier of the second user is present (fig 3; fig 5; col 7, lines 65-67; col 8, lines 1-8), wherein the preexisting identifier enables communication with the second user independent of the value exchange system (fig 4; col 8, lines 60-67; col 9, lines 1-46). The pre-existing identifier may include telephone number or electronic mail address (col 13, line 7; col 10, line 11). A value may be transferred between the first user and the second user (col 3, lines 4-5).

The value is receivable by the second user: as a redeemable voucher (fig 6, col 12, lines 66-67; col 13, lines 1-11) or web certificate (col 13, lines 12-26) by selecting an electronic link provided to the second user. The value to be exchanged is receivable by the second user through a debit card (col 16, lines 59-67; col 17, lines 1-4). The steps to Doggett et al are not precluded from being repeated multiple times. Asymmetric cryptographic scheme is applied to secure said value exchange transaction (col 4, lines 59-67).

A database (72; fig 3; col 7, lines 57-58), synchronization (90; fig 4; col 8, lines 60-64), communication (91 and 93; fig 4; col 8, lines 65-67), financial (col 10, lines 22-30), and security configured to authenticate a digital transaction certificate that may be used to authenticate said value exchange transaction (col 3, lines 30-65; col 11, lines 47-67; col 20, lines 11-21).

It would have been obvious to one with ordinary skill in the art to include to Doggett et al separate servers for synchronization, communication, financial, and security for the purposes of network efficiencies.

Doggett et al does not explicitly describe their system as either a: "value exchange", "distributed exchange", "distributed transaction", or "distributed financial services". Since Doggett et al involves value which is exchanged, there is present a system that is value exchange. Since Doggett et al involves the distribution of: exchange, transactions, and financial services, there is present a system that is a: value exchange, distributed exchange, distributed transaction and distributed financial service.

Doggett et al does not explicitly disclose:

registering a first user with the system, or further when creating the account or receiving the value exchange transaction;

registering the second user with the value exchange system if not already registered, or further when creating the second account;

notification generation and sending said notification to the second user (including means for notifying), and allocating said value between said first account and a second account associated with the second user.

Kasai et al discloses registering users with a system (col 3, lines 35-66), and a value exchange system including: notification generation and sending said notification to the second user, including means for notifying (col 5, lines 28-32), and allocating said value between said first account and a second account associated with the second user (col 5, lines 32-45).

It would have been obvious to one with ordinary skill in the art to register first and second users to Doggett et al because of what is taught by Kasai et al. Kasai et al teaches that financial contract obligations between a user and a system provider require certain parameters to be established (i.e. registered) before service is provided (col 3, lines 35-67).

It would have been obvious to one with ordinary skill in the art to include a value exchange system including: notification generation sending said notification to the second user (including means for notifying), and allocating said value between said first account and a second account associated with the second user to Doggett et al because of what is taught by Kasai et al. Kasai et al teaches notification for purposes of verification (col 5, lines 30-32).



7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett in view of Kasai et al as applied to claim s 1-6, 8-11, 20, 22, 24-25, 34-39, 44-47 above, and further in view of Remington et al

Doggett in view of Kasai et al does not explicitly disclose the redeemable voucher including an electronic advertisement.

Remington et al discloses a redeemable voucher including an electronic advertisement (213; fig 7, col 10, lines 30-33).

It would have been obvious to one with ordinary skill in the art to include an electronic advertisement in the redeemable voucher to Doggett in view of Kasai et al because of what is taught by Remington et al. Remington et al teaches advertisements for the purposes of providing new services or for target marketing by a system provider (col 14, lines 60-67)

8. Claims 12-16, 18-19, 30-33, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett in view of Kasai et al as applied to claims 1-6, 8-11, 20, 22, 24-25, 34-39, 44-47 above, and further in view of Nikander.

Doggett et al in view of Kasai et al does not explicitly disclose:

establishing a link between a first user's mobile computing device a second user on a mobile client device for the value exchange transaction through a wireless network; and

the mobile communication device is: a personal digital assistant or a telephone.

Nikander discloses establishing a link between a first user's mobile computing device a second user on a mobile client device for the value exchange transaction through a wireless network (fig 6). Nikander also discloses a personal digital assistant (206), a telephone (202).

It would have been obvious to one with ordinary skill in the art to establishing a link between a first user's mobile computing device a second user on a mobile client device for the value exchange transaction through a wireless network to Doggett et al in view of Kasai because of what is taught by Nikander. Nikander teaches that it is advantageous to use mobile communication for financial transactions (col 11, line 59).

It would have been obvious too one with ordinary skill in the art to include either a personal digital assistant a telephone because Nikander discloses functional equivalency in absence of unexpected or unobvious results.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett et al in view of Kasai et al in further view of Nikander as applied to claims 12-16, 18-19, 30-33, and 41 above, and further in view of Borgatahi et al.

Doggett et al in view of Kasai et al in further view of Nikander does not explicitly disclose two-way pagers.

Borgatahl et al discloses two-way pages (col 5, lines 20-30).

It would have been obvious to one with ordinary skill in the art to include two-way pagers as an alternative for establishing a link to users because Borgatahl teaches functional equivalence (col 5, lines 20-30).

10. Claims 21, 23, 26-28, 40, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett et al in view of Kasai as applied to claims 1-6, 8-11, 20, 22, 24-25, 34-39, 44-47 above, and further in view of Downing et al.

Doggett et al in view of Kasai does not explicitly disclose:

value that may be converted from between currencies;

value that may be held in escrow with an escrow party; and

an identifier of a second user not registered with the distributed transaction system.

Downing et al discloses: an identifier of a second user that is not registered (col 7, lines 6-17). Also disclosed is: value converted from between currencies that depends

on the pre-existing identifier (col 9, lines 22-26), and value held in escrow with an escrow party (col 8, lines 45-67).

It would have been obvious too one with ordinary skill in the art to modify Doggett et al in view of Kasai to include an identifier of a second user that is not registered because Downing et al teaches that there are customers that are not readily available to access registered systems (col 1, lines 55-67; col 2, lines 1-36 ) but need quick access to value transfers (col 3, lines 24-26).

It would have been obvious too one with ordinary skill in the art to modify Doggett et al in view of Kasai to include value that may be converted from between currencies that depends on the pre-existing identifier because of what is taught by Downing et al. Downing et al teaches value exchange may require currency conversion if international in nature (col 9, lines 22-26).

It would have been obvious too one with ordinary skill in the art to modify Doggett et al in view of Kasai to include value that may be held in escrow with an escrow party because of what is taught by Downing et al. Downing et al teaches advantages of the sender to have an escrow (col 8, lines 45-67).

11. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett in view of Kasai et al in further view of Downing as applied to claims 21, 23, 26-28, 40, 43 above, and further in view of Nikander.

Doggett et al in view of Kasai et al in further view of Downing does not explicitly disclose an instruction received through a mobile communication device.

Nikander discloses establishing a link between a first user's mobile computing for the value exchange transaction through a wireless network (fig 6).

It would have been obvious to one with ordinary skill in the art to include to Doggett et al in view of Kasai et al in further view of Downing an instruction received through a mobile communication device because of what is taught by Nikander. Nikander teaches that it is advantageous to use mobile communication for financial transactions (col 11, line 59).

12. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett et al in view of Kasai as applied to claims 1-6, 8-11, 20, 22, 24-25, 34-39, 44-47 above, and further in view of Perkins and Nikander.

Doggett et al in view of Kasai does not disclose:

a value receiver identifiable only by an electronic mail address.

Perkins discloses a value receiver identifiable only by an electronic mail address (col 2, lines 61-67; col 3, lines 1-14).

It would have been obvious too one with ordinary skill in the art to include a value receiver identifiable only by said electronic mail address to execute a transfer because of what is taught by Nikander and Perkins. Perkins teaches that for mobile communications it is advantageous to use solely the Internet address to identify a value receiver (col 2, lines 4-12, lines 61-67; col 3, lines 1-39), and Nikander teaches that it is advantageous to use mobile communication for financial transactions (col 11, line 59).

### ***Response to Arguments***

13. Applicant's arguments filed 10-22-02 have been fully considered but they are not persuasive.

Doggett does not teach away from the additional use of notification provided by Kasai (combined for the reasons as given in the office action). Since Doggett discloses the use of the e-mail address that is sent with the transfer, there is the "use of the party's electronic mail in an actual transfer".

Regarding recitation "without requiring a user to initiate a communication to another user", this is present to Doggett et al. Because Doggett et al teaches using a network, this provides indirect communication between parties, thus meeting the recitation as broadly recited.

Regarding recitation "registering a first user with the value exchange system", it would have been obvious to one with ordinary skill in the art to include such to Doggett et al since Doggett et al teaches that a user uses e-mail, which inherently requires

registering with an internet service provider (part of a value exchange system – as broadly recited) for providing such service.

Regarding arguments to claims now rejected with a new art combination, these arguments are considered moot.

### ***Conclusion***

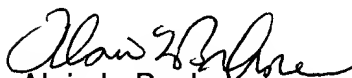
14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Arunachalam and Pepe et al disclose network systems.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 703-308-1884. The examiner can normally be reached on about 7:30 am to 5:00 pm (Alternate Fridays Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1113.

  
Alain L. Bashore  
April 17, 2003